

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed April 23, 2004 ("*Office Action*"). At the time of the Office Action, Claims 1-50 were pending in the Application. Applicants amend Claims 1, 2, 7, 8, 9, 17, 18, 23, 24, 25, 33, 34, 39, 40, and 41 to further clarify what Applicants consider to be the invention. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 102 Rejections

The Examiner rejects Claims 1, 5, 7, 8, 12, 14-17, 21, 23, 24, 28, 30-33, 37, 39, 40, 44, and 46-48 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,415,269, which issued to Dinwoodie ("*Dinwoodie*"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131.

Applicants' independent Claim 1, as amended, recites:

A method for controlling audio content during a multiparty communication session, comprising:

establishing a multiparty communication session involving a plurality of participants, each participant associated with a device;

after establishing the multiparty communication session, prompting the participants to identify themselves as active participants; and

disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

Applicants respectfully submit that *Dinwoodie* fails to describe every element of this Claim. In general, *Dinwoodie* regards an interactive remote auction bidding system. More particularly, *Dinwoodie* discloses requiring bidders phoning an auction site to input correct passwords and other information prior to being linked to an auction site and prior to commencement of an auction.

Among other aspects of Claim 1, *Dinwoodie* fails to describe “establishing a multiparty communication session involving a plurality of participants, each participant associated with a device” and “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.” The Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. *Office Action*, p. 2-3. However, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller is prompted to enter the password, PIN, and bidder number, the caller still has not linked to the auction site, let alone participated in an established “multiparty communication session involving a plurality of participants.” When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. Thus, *Dinwoodie* fails to describe “establishing a multiparty communication session involving a plurality of participants, each participant associated with a device” and “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.”

With regard to *Dinwoodie*, the Examiner states that “the bidder/caller becomes a member of the conference call or active participant at the time he or she is prompted to enter an identification such as a password, a PIN, a bidder number.” *Office Action*, p. 2. Applicants respectfully disagree. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not participated in the auction, let alone in “a multiparty communication session involving a plurality of participants.” For at least these reasons, *Dinwoodie* fails to describe “establishing a multiparty communication session involving a plurality of participants, each participant associated with a device” and “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.”

Furthermore, *Dinwoodie* also fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone communicated media to other devices in a multiparty communication session. Thus, in *Dinwoodie* there is no “particular device previously used by one of the participants” from which to disable media. Furthermore, there is no “communication of the media from the particular device to other devices in the multiparty communication session” to be terminated. For at least these reasons, *Dinwoodie* fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.”

For at least all of these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claim 1. For analogous reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 17 and 33. Claims 5, 7, 8, 12, 14-16, 21, 23, 24, 28, 30-32, 37, 39, 40, 44, and 46-48 depend from Claims 1, 17, or 33. Thus, because they depend from independent claims shown above to be allowable over *Dinwoodie*, Applicants also respectfully request the Examiner to reconsider and withdraw the rejection of Claims 5, 7, 8, 12, 14-16, 21, 23, 24, 28, 30-32, 37, 39, 40, 44, and 46-48.

Section 103 Rejections

The Examiner rejects the remaining claims as obvious under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art

reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. §2143.

Claims 6, 9-11, 22, 25-27, 38, and 41-43

The Examiner rejects Claims 6, 9-11, 22, 25-27, 38, and 41-43 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie* in view of U.S. Patent No. 6,556,670, which issued to Horn ("*Horn*"). Each of these claims depends from an independent Claim shown above to be allowable over *Dinwoodie*. The introduction of *Horn* fails to provide the elements of Applicants' independent claims not shown by *Dinwoodie*. Thus, because the cited references fail to teach or suggest all of the claim limitations, the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Dinwoodie* and *Horn* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. §2143.01 (emphasis in original). Thus, the mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. Moreover, nothing in *Dinwoodie* or *Horn* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. For this additional reason, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 6, 9-11, 22, 25-27, 38, and 41-43.

Claims 2-4, 13, 18-20, 29, 34-36, and 45

The Examiner rejects Claims 2-4, 13, 18-20, 29, 34-36, and 45 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie* in view of U.S. Patent No. 6,457,045, which issued to Hanson, et al. ("*Hanson*"). Each of these claims depends from an independent Claim shown above to be allowable over *Dinwoodie*. The introduction of *Hanson* fails to provide the elements of Applicants' independent claims not shown by *Dinwoodie*. Thus, because the cited references fail to teach or suggest all of the claim limitations, the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Dinwoodie* and *Hanson* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. As discussed above, the Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. §2143.01 (emphasis in original). Thus, the mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. Moreover, nothing in *Dinwoodie* or *Hanson* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. For this additional reason, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 2-4, 13, 18-20, 29, 34-36, and 45.

Claim 49

The Examiner rejects Claim 49 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie*. Claim 49 recites:

A method for handling on-hold endpoints in a conference call, comprising:
receiving an audio stream from each of a plurality of participants to a conference call;
receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint;
prompting each participant to send a reply to a prompt;
receiving replies from active participants to the conference call; and
terminating media from devices associated with each participant not sending a reply.

Applicants respectfully submit that *Dinwoodie* fails to teach or suggest every element of this Claim.

The Examiner concedes that *Dinwoodie* fails to teach or suggest “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint.” *Office Action*, p. 6. However, the Examiner states that “[p]utting the conference call on-hold by the participant is well known.” *Id.* However, the Examiner has not indicated that “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint” is well known in the prior art, or that this limitation is disclosed by *Dinwoodie* or any other reference. Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, Applicants respectfully submit that *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.” The Examiner apparently assumes that *Dinwoodie* teaches or suggests this element. *See Office Action*, p. 6. However, as discussed above with regard to Claim 1, *Dinwoodie* discusses a series of steps a bidder must take before being linked to an auction site and before commencement of an auction. The steps include entering an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller enters the password, PIN, and bidder number, the caller still has not

actively participated in the auction, let alone in a conference call. When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not actively participated in the auction or any conference call at the time he or she enters the requested information. Thus, *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.”

With regard to *Dinwoodie*, the Examiner states that “the bidder/caller becomes a member of the conference call or active participant at the time he or she is prompted to enter an identification such as a password, a PIN, a bidder number.” *Office Action*, p. 2. As discussed above with regard to Claim 1, Applicants respectfully disagree. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not actively participated in the auction, let alone in a conference call. For at least these reasons, *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.”

In addition, Applicants respectfully submit that *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.” As discussed above with regard to Claim 1, *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone communicated media in a conference call. Thus, in *Dinwoodie* there is no media to be terminated. For at least this reason, *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.”

For at least all of these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 49.

Claim 50

The Examiner rejects Claim 50 under 35 U.S.C. §103(a) as being unpatentable over *Horn* in view of *Dinwoodie*. Claim 50 recites:

A conference bridge, comprising:
an input buffer operable to receive and buffer audio streams generated by participants of a multiparty communication session;
a cross-connect operable to cross-connect an audio stream from each participant to conference output stream generators for remaining participants;
the conference stream output generator for each participant operable to combine each audio stream received from the cross-connect multiple independently controlled by the participant and to generate a conference output stream for the participant;
an output buffer operable to receive and buffer the conference output streams for transmission to the participant;
and
an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants.

Applicants respectfully submit that *Horn* in view of *Dinwoodie* fails to teach or suggest every element of this Claim.

Among other aspects of Claim 50, *Horn* in view of *Dinwoodie* fails to teach or suggest “an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants.” The Examiner concedes that *Horn* fails to teach or suggest this claim element. *Office Action*, p. 7. Instead, the Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. *Office Action*, p. 7-8. However, as discussed above with regard to Claims 1 and 49, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller communicates the password, PIN, and bidder number, the caller still has not participated in the auction, let alone in a multiparty communication session. When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. Thus, *Dinwoodie* fails to teach or suggest “an

on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants.”

With regard to *Dinwoodie*, the Examiner states that “the bidder/caller becomes a member of the conference call or active participant at the time he or she is prompted to enter an identification such as a password, a PIN, a bidder number.” *Office Action*, p. 8. As discussed above with regard to Claims 1 and 49, Applicants respectfully disagree. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not participated in the auction, let alone in a multiparty communication session. For at least these reasons, *Dinwoodie* fails to teach or suggest “an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants.”

Furthermore, *Dinwoodie* also fails to teach or suggest “an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable audio streams generated by devices associated with non-active participants.” *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone generated audio streams. Thus, in *Dinwoodie* there are no “audio streams generated by devices associated with non-active participants” to be disabled. For at least these reasons, *Dinwoodie* fails to describe “an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable audio streams generated by devices associated with non-active participants.”

In addition, as discussed above, Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Horn* and *Dinwoodie* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual

question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original). Thus, the mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. Moreover, nothing in *Horn* or *Dinwoodie* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. For this additional reason, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

For at least all of these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 50.

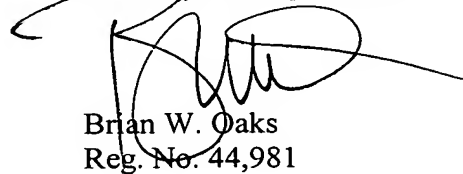
Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

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